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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,104	11/10/1999	ASGEIR SAEBO	CONLINCO-040	8881
23535	7590	10/01/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			JONES, DWAYNE C	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/438,104

Applicant(s)

SAEBO ET AL.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the remarks of 17MAY2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/22/00.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 7-24 are pending.
2. Claims 7-24 are rejected.

Response to Arguments and Declaration

3. Applicant's arguments and declaration filed May 17, 2004 have been fully considered but they are not persuasive with respect to Cain et al. Applicant's appellant and the Inventor in the declaration made the following arguments. First, applicants argue that since the Saebo declaration establishes that the product obtained by Cain et al. contained greater than 1% of the 8,10 and 11,13 isomers of CLA, the prior art reference of Cain et al. does not render the instant invention obvious. Second, applicants argue that even though that the term of comprising is present the instant claims specify that the compositions must contain less than 1% of 8,10 and 11,13 isomers. Third, applicants next allege that the interpretations of the data in the Saebo Declaration are flawed. Fourth, applicants purport that complete hindsight reconstruction was used by the Examiner in analyzing sigmatropic rearrangement analysis.

4. First, applicants argue that since the Saebo declaration establishes that the product obtained by Cain et al. contained greater than 1% of the 8,10 and 11,13 isomers of CLA, the prior art reference of Cain et al. does not render the instant invention obvious. Applicants' particularly point out that Mr. Saebo purports that the

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Cain et al. method "resulted in a conjugated linoleic acid composition comprising approximately 3.49% c11,t13 CLA and 2.24% t9,t11 and t10,t12 CLA."

5. However, it is noted that the instant claims are (1) only directed to composition claims of known prior art compounds of c9,t11-octadecdienoic acid and t10,c12-octadecdienoic acid that must be present in at least 50% of the composition, and (2) this composition of known conjugated linoleic acid must contain less than 1% of the 11,13-octadecadienoic acid and 8,10-octadecadienoic acid isomers. In addition, Cain et al. teach of compositions of conjugated linoleic acid that are used in food products for both animals and humans, (see page 1). Cain et al. teach of a 91.8% conjugated linoleic acid product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer, (see Example 1). Clearly, from this cite, Cain et al. has met the requirements that are claimed in the instant invention. Although Cain et al. do not specifically discuss peak area percentages of the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid, it would have been obvious to one having ordinary skill in the art that these isomers would be less than 1% of a peak area because Cain et al. teach of a conjugated linoleic acid composition product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer. Furthermore, it is pointed out that the data set forth by Applicant of Saebo in the declaration that was proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. Accordingly, it is well established through case law "that it is not a difficult matter to carry out a process in such a fashion that it would not be successful and, therefore, the failures of experimenters who have no interest in

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succeeding should not be accorded great weight", see *In Re Michalek*, 74 USPQ 108, at 109 citing *Bullard Company et al. v. Coe*, 147 F.2d. 568, 64, USPQ 359.

6. Second, applicants argue that even though that the term of comprising is present the instant claims specify that the compositions must contain less than 1% of 8,10 and 11,13 isomers. The prior art reference of Cain et al. specifically state that of the eight geometric isomers of CLA the isomers of c9, t11 and t10, c12 are the most abundant with about equal concentrations. Cain et al. provide motivation to the skilled artisan to decrease the production of the isomers, which includes 11,13-octadecadienoic acid and 8,10-octadecadienoic acid, and even trans-trans-octadecadienoic acid, with the following statement that the, "two most abundant isomers [c9, t11 and t10, c12] are responsible for the beneficial effects of the compositions containing CLA's, (see page 1, lines 8-11 and 20-25). The skilled artisan is provided with the clear motivation to decrease production of undesired CLA isomers, thus producing compositions of the desired c9, t11- and t10, c12-isomers of CLA. In fact, Cain et al. provide evidence of this preferred and desired composition of obtaining higher concentrations of the desired c9, t11- and t10, c12-isomers of CLA with a conjugated linoleic acid (CLA) composition, which has 91.8% of CLA, which is further broken down into 49.7% was the 9,11-isomer and 50.3% was the 10,12-isomer, (see page 11, lines 14-17). Accordingly, all the necessary and required parts (wheels) are clearly taught and exemplified by Cain et al.

7. Third, applicants next allege that the Examiner's interpretations of the data in the Saebo Declaration are flawed because the 8,10 isomer occurring in equal proportion to the c9,t11-isomer, not the c11,t13-isomer as stated in the Declaration. This allegation is

not found persuasive because one having ordinary skill in the art is clearly provided with the necessary information and clear teaching that the, "two most abundant isomers [c9, t11 and t10, c12] are responsible for the beneficial effects of the compositions containing CLA's, (see page 1, lines 8-11 and 20-25), which provides motivation to decrease other isomers, namely the 11,13-octadecadienoic acid and 8,10-octadecadienoic acid isomers. One skilled in the art would be flawed if they disregarded this teaching to increase or augment the concentration of the desired and , "two most abundant isomers [c9, t11 and t10, c12] are responsible for the beneficial effects of the compositions containing CLA's. The fact still remains that Cain et al. teach of a composition with a fatty acid distribution as determined by FAME GC of a product that contains 91.8 % conjugated linoleic acid of which is 49.7% was the c9,t11 isomer and 50.3 % was the t10,c12 isomer, (see page 11, Example 1). Cain et al. even present their data to 0.1 % accuracy, which further supports the fact that the instant claims are clearly rendered obvious in view of Cain et al.

8. In addition, even applicant acknowledges that there is ambiguity with the co-elution between t8, c10 isomer and the c9, t11 isomer of CLA with the phrase, "but almost always occurs in a one to one proportion." Clearly, this admission allows for variances with the co-elution of these isomers that could very well give different ratios of the isomers and thus fall within the instantly claimed ranges. Moreover, as previously indicated the data set forth by Saebo in the declaration that was proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties.

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9. Fourth, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The fact remains that sigmatropic reactions are well known in the art as reactions that are controlled by molecular orbital symmetry characteristics. The previous analysis of sigmatropic rearrangement was abstracted directed from prior art sources, namely Solomons and Carey. In particular, applicants state that Solomons and Carey are silent to sigmatropic rearrangement of a particular class of conjugated bond systems of octadecadienoic acid. However, this statement is irrelevant because these sources, as do other prior art references and journals and textbooks, provide the skilled artisan with the necessary and general information to avoid the generation of undesired side products caused by increased thermal energy. Prior art sources such as these provide the skilled artisan with the general principles to be applied in similar or related systems. It would have been obvious to the skilled artisan in organic chemistry to utilize these well-established Woodward-Hoffmann Rules in conjugated systems, such as CLAs, artisan to decrease the temperatures in order to control the production of the sigmatropic products, namely the 8,10- and 11,13-octadecadienoic acid isomers.

Information Disclosure Statement

10. Again, it is respectfully requested any documents, in particular the two references presented in the response of November 22, 2000 on page 3 of 3, that are furnished to the Office by listed on an information disclosure statement to ensure that they are properly reviewed and considered.

Claim Rejections - 35 USC § 112

11. The rejection of claims 7-24 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for c9, t11-octadecadienoic acid and t10, c12-octadecadienoic acid, does not reasonably provide enablement for other 9,11 and 10,12 isomers of octadecadienoic acid is withdrawn in response to the amendment of May 17, 2004.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. The rejection of claims 7-24 under 35 U.S.C. 103(a) as being unpatentable over Cain et al. of WO 97/18320 is maintained and repeated. Cain et al. teach of compositions of conjugated linoleic acid that are used in food products for both animals and humans, (see page 1). Cain et al. teach of a composition that contains 91.8% conjugated linoleic acid product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer, (see Example 1). In addition, Cain et al. teach of alkyl esters of these conjugated linoleic acids (see Examples 1 and 3) as well as conjugated linoleic acid triglycerides, (see Example 8). Cain et al. also teach of utilizing

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the characterization method of HPLC as well as GC (see Example 8). Although Cain et al. do not specifically discuss peak area percentages of the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid, it would have been obvious to one having ordinary skill in the art that these isomers would be less than 1% of a peak area because Cain et al. teach of a conjugated linoleic acid composition product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer. Accordingly, Cain et al. teach of a composition which contains a total of 100 % of both the isomers of cis 9, trans 11-isomer and which would obviously exclude any other isomers, including but not limited to 11,13-octadecadienoic and 8,10-octadecadienoic acid. In addition, Cain et al. teach of utilizing the characterization method of HPLC as well as GC, which are known to present data results of analyzed products as percentages based on peak areas. Accordingly, it would have been obvious to one having ordinary skill in the art to express the isomers of conjugated linoleic acid as peak area percentages especially when the prior art reference of Cain et al. teach of using the characterization techniques of HPLC and GC, (see the Examples of Cain et al.)

Obviousness-type Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 8, 9, 11, 12, 14, 15, 17, 18, 20, 21, and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/623,825. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and copending Application No. 10/623,825 teach of esters and triglycerides of octadecadienoic acids that have c9,t11- and t10,c12-octadecadienoic acid contents greater than 50% and a content of 8,10- and 11,13-octadecadienoic acid isomers less than 5%, which embraces the instantly claimed 1%.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 7-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 8 of copending Application No. 09/132,593. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and copending Application No. 09/132,593 teach of esters and triglycerides of compositions of octadecadienoic acids that have c9,t11- and t10,c12-octadecadienoic acid contents greater than 50% and a content of 8,10- and 11,13-octadecadienoic acid isomers less than 2%, which embraces the instantly required 1% limitation. In addition, copending Application No. 09/132,593 teaches of food products of these compositions.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 8, 9, 11, 12, 14, 15, 17, 18, 20, 21, and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-8 and 13-17 of copending Application No. 09/271,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant invention as well as copending Application No. 09/271,024 teach of composition of esters and glycerides of octadecadienoic acid that have contents of at least 30% c9,t11- and t11,c12-octadecadienoic acid and less 1% of 8,10- and 11,13 octadecadienoic acids. In addition, copending Application No. 09/271,024 593 teaches of food products of these compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

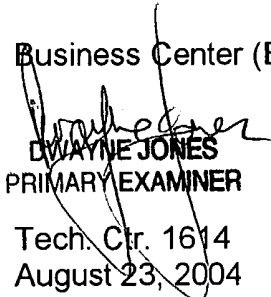
Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Thursday, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (703) 872-9306.

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Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

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DWAYNE JONES
PRIMARY EXAMINER

Tech. Ctr. 1614
August 23, 2004